IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants:	Frank J. McConnell et al.	Attorney Docket No. SACO115537
Application No:	09/658,770	Art Unit: 3626 / Confirmation No.: 4422
Filed:	September 11, 2000	Examiner: Natalie Pass
Title:	METHOD AND SYSTEM FOR PROVIDING INSURANCE POLICIES VIA A DISTRIBUTED COMPUTING NETWORK	

APPELLANTS' SECOND REPLY BRIEF

July 19, 2006

TO THE COMMISSIONER FOR PATENTS:

Safeco Insurance Company of America (hereinafter "Safeco") has reviewed the Supplemental Examiner's Answer submitted in response to appellants' first Reply Brief. As explained in the Appeal Brief, the first Reply Brief, and supplemented below, the cited and applied references do not teach or suggest the claimed invention. Appellants submit this Second Reply Brief in response to the Supplemental Examiner's Answer. A reversal of the decision of the Examiner and issuance of the patent application is respectfully requested.

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I.   SUMMARY OF THE SUPPLEMENTAL EXAMINER'S ANSWER

Appellants filed an Appeal Brief on February 22, 2005, in the United States Patent and Trademark Office (hereinafter "the Office"). The Office mailed an Examiner's Answer on August 2, 2005, using a repealed section of the C.F.R. to focus on Claim 1. Appellants filed a first Reply Brief on September 29, 2005, and the Office mailed a Supplemental Examiner's Answer on May 23, 2006, that is substantially a verbatim copy of the original Examiner's Answer.

Without admitting to the propriety of the arguments of the Examiner, both in law and in facts, this Second Reply Brief follows in which appellants note the lack of response by the Examiner to the arguments in the first Reply Brief, clarify one additional point made by the Examiner's arguments, and further entreat the Board of Appeals and Interferences (hereinafter "the Board") to reverse the final rejection of Claims 1, 3-8, and 10-19.

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II.   REPLY ARGUMENT

A.   <u>The Examiner Did Not Respond to the Arguments Raised in the First Reply Brief</u>

In the first Reply Brief, appellants explained that a bindable quotation is not a binding agreement. The claimed invention requires a "bindable insurance premium quotation" whereas Mitcham, the applied reference, teaches a binding agreement. Appellants also explained that Mitcham expressly discloses one embodiment, which reads as follows:

> By utilizing kiosk 12, the user may independently create a binding agreement, such as an insurance agreement, <u>without the need for interacting with a representative of the other party, such as a representative of an insurance company</u>.

See Col. 4, lines 9-12 (emphasis provided). Appellants further explained that the claimed invention requires "transmitting an electronic version of said insurance policy <u>to an individual insured by said insurance policy</u>." See Claim 3. The Examiner indicated that Mitcham discusses "transmitting the insurance policy via the communication means <u>to an underwriter</u>." See Col. 10, lines 33-34, of Mitcham. Appellants reasoned that an individual insured by an insurance policy is not identical to an underwriter.

Examiner declared that these issues "substantially repeat arguments previously made in the appeal brief," hence avoiding the need to substantively respond to them in the Supplemental Examiner's Answer. Appellants have requested that the Examiner refrain from intimating that the Mitcham reference need not disclose the identical invention. In response, the Examiner asked appellants to provide documentation for the allegation. The fact that the claimed invention, as recited by Claim 3, requiring "transmitting an electronic version of said insurance policy to an individual insured by said insurance policy" was equated by the Examiner to the text

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"transmitting the insurance policy via the communication means to an underwriter" of Mitcham clearly indicates a lack of identity between the claimed invention and what is taught by Mitcham.

B. **Instead of Giving the Claimed Invention the Broadest Reasonable Interpretation Consistent With the Specification, the Examiner Gave Mitcham the Broadest, Most Unreasonable Interpretation**

M.P.E.P. § 2131.01 provides that "[d]uring an examination, the claims are given the broadest reasonable interpretation consistent with the specification," citing favorably, *In re Morris*, 127 F.3d 1048, 44 U.S.P.Q.2d 1023 (Fed. Cir. 1997). The specification referred to by the M.P.E.P. is the specification of the pending patent application being examined by the Examiner and not the applied reference, such as Mitcham. Here is the Examiner's response in view of the guidance from the case law:

> Furthermore, Examiner notes that as documented in the applied art, Mitcham teaches allowing the user to select the option "having a representative of an insurance company contact the user" (Mitcham, column 6, lines 21-23) and reintermediating an insurance agent by stating "to purchase your policy, please contact AUTOSURE at (214) 325-3001" (Mitcham; Figure 13, lines 32-34). The Examiner is giving the words "representative of an insurance company" the broadest reasonable interpretation and understands a representative who can sell insurance to be an "insurance agent."

See p. 18 of the Supplemental Examiner's Answer (emphasis provided). The claimed invention requires "an insurance agent" as recited in Claim 1. The Examiner cannot interpret broadly the disclosure of the Mitcham reference, and then use the broadened disclosure to reject the claimed invention. This is not permitted.

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Appellants have explained that, for many years, Safeco sold its insurance policies solely through independent agents. The emergence of on-line sales of insurance policies poses a challenge to companies such as Safeco that sell primarily through independent agents. The claimed invention allows Safeco to benefit its independent agents by selling on-line insurance policies.

III.   CONCLUSION

This Second Reply Brief maintains that the cited and applied references are not prior art as used in the final rejection of Claims 1, 3-8, and 10-19. The Examiner did not respond to the arguments posed by the first Reply Brief, namely, that a bindable quotation is not a binding agreement; that the existence of the only embodiment in Mitcham is the one allowing a user to independently create a binding agreement without the need to interact with a representative of an insurance company; and that an underwriter is not an insured individual under an insurance policy. The Second Reply Brief further questions the propriety of broadly interpreting the disclosure of the applied and cited references, which is prohibited under the current case law.

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IV.   CLAIMS APPENDIX

1.   A method for providing an insurance policy via a distributed computing network, comprising:

receiving a request for a bindable premium quotation for an insurance policy;

in response to said request, receiving information relating to the insurability of an individual to be insured by said insurance policy and information relating to the coverage to be provided by said insurance policy;

gathering underwriting information from one or more outside information resources based upon the identify of said individual;

determining whether said insurance policy may be underwritten;

in response to determining that said insurance policy may be underwritten, calculating a premium for said insurance policy and providing said premium to a requestor of said premium quotation as a bindable insurance premium quotation;

receiving a request to purchase said insurance policy according to said bindable insurance premium quotation; and

in response to said request, re-intermediating an insurance agent and issuing said insurance policy.

3.   The method of Claim 1, wherein issuing said insurance policy comprises transmitting an electronic version of said insurance policy to an individual insured by said insurance policy.

4. The method of Claim 1, wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents;

receiving the selection of a selected agent from the list of available insurance agents;

assigning said selected insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said selected insurance agent; and

remitting a commission to said selected insurance agent.

5. The method of Claim 1, wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual;

receiving the selection of a selected agent from the list of available insurance agents;

assigning said selected insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said selected insurance agent; and

remitting a commission to said selected insurance agent.

6. The method of Claim 1, wherein re-intermediating an insurance agent comprises:

assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual;

assigning said assigned insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said assigned insurance agent; and

remitting a commission to said assigned insurance agent.

7.   The method of Claim 6, wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer.

8.   A system for providing an insurance policy via a distributed computing network, comprising:

a server computer maintaining a virtual insurance producer Web site available via said distributed computing network, and wherein said virtual producer Web site is operative to:

receive a request for a bindable premium quotation for an insurance policy;

receive information relating to the insurability of an individual to be insured by said insurance policy and information relating to the coverage to be provided by said insurance policy in response to said request;

gather underwriting information from one or more outside information resources based upon the identify of said individual;

determine whether said insurance policy may be underwritten;

to calculate a premium for said insurance policy and to provide said premium to a requestor of said premium quotation as a bindable insurance premium quotation;

receive a request to purchase said insurance policy according to said bindable insurance premium quotation;

re-intermediate an insurance agent; and

issue said insurance policy.

10. The system of Claim 8, wherein said virtual producer Web site is further operative to:

provide an interactive help system to a requestor of said insurance policy.

11. The system of Claim 10, wherein said interactive help system comprises an interactive chat facility for providing real-time communication between said requestor of said insurance policy and an insurance help-desk representative.

12. The system of Claim 11, wherein said interactive help system further comprises an e-mail facility for receiving an electronic mail message from said requestor of said insurance policy and transmitting said message to an insurance help-desk representative.

13. The system of Claim 12, wherein said interactive help system further comprises a facility for notifying an insurance help-desk representative that said requestor of said insurance policy would like to receive a telephone call providing assistance.

14. The system of Claim 8, wherein issuing said insurance policy comprises transmitting an electronic version of said insurance policy to an individual insured by said insurance policy.

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15.   The system of Claim 14, wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents;

receiving the selection of a selected agent from the list of available insurance agents;

assigning said selected insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said selected insurance agent; and

remitting a commission to said selected insurance agent.

16.   The system of Claim 14, wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual;

receiving the selection of a selected agent from the list of available insurance agents;

assigning said selected insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said selected insurance agent; and

remitting a commission to said selected insurance agent.

17.   The system of Claim 14, wherein re-intermediating an insurance agent comprises:

assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual;

assigning said assigned insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said assigned insurance agent; and

remitting a commission to said assigned insurance agent.

18.   The system of Claim 17, wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer.

19.   A computer-readable medium containing computer-executable instructions which, when executed by a computer, cause the computer to perform the method of Claims 1, 3, 4, 5, 6, or 7.

Respectfully submitted,
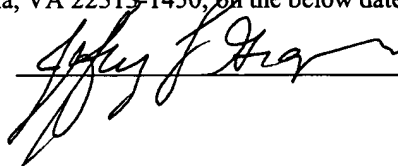
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited in triplicate with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: July 19, 2006

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